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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,054	09/26/2003	Laurie Engel	02-1031-A	1228
20306 7590 05/02/2007 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			EXAMINER FORD, VANESSA L	
			ART UNIT 1645	PAPER NUMBER
			MAIL DATE 05/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/673,054

Applicant(s)

ENGEL ET AL.

Examiner

Vanessa L. Ford

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 125.
Claim(s) objected to: NONE.
Claim(s) rejected: 1-3, 6-12, 16-28, 67-77, 79 and 122-124.
Claim(s) withdrawn from consideration: 4, 5 and 13-15.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.



Continuation of 11. does NOT place the application in condition for allowance because: Applicant has argued the same points in their After-final response as they argued in the response to the Non-Final action.

Briefly, Applicant urges that the Office did not establish a case prima facie obviousness. Applicant argues that there is no motivation to combine the prior art references. Additionally, Applicant states that the claims are non-obvious over the cited art because of unexpected results. As explained in the Final action mailed 1/30/07, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the claims are directed to a composition comprising at least one surfactant having a lipophilic balance value in the range of about 11 to about 16 and at least one cell membrane altering compound. Chu et al teach compositions comprising aqueous solutions of octylthioglucoiside used for lysing cells in the protein extraction process and further teach that the octylthioglucoisides (cell membrane altering compound) of the invention can release the protein of interest from the cell membrane or cell wall. Chu et al do not teach cationic surfactants comprising ethoxylated amine such as Tomah E -18-15 or Tomah E-18-5 (see the Abstract and column 1). Chu et al teach that other constituents which do no adversely effect the use and benefits of the solution can be added to the invention such as buffers or constituents that influence by the protein that is being expressed (column 2). However, Shultz et al teach that cationic surfactants such as Tomah E -18-15 or Tomah E-18-5 are used to stabilize protein compositions (see the Abstract and columns 1-2). One of ordinary skill in the art would be motivated to add Tomah E -18-15 and/or Tomah E-18-5 to aqueous solutions of Chu et al comprising octylthioglucoisides because Shultz et al teach that cationic surfactants such as Tomah E -18-15 or Tomah E-18-5 can be used to stabilize proteins in both storage buffers and reaction enzymes in solution. One ordinary skill in the art would reasonably conclude that the addition cationic surfactants such as Tomah E -18-15 or Tomah E-18-5 would provide a stable aqueous solution.

To address Applicant's comments regarding unexpected results, it should be remembered that MPEP at section 2112.01 states "products of identical chemical composition can not have mutually exclusive properties". Thus, the compositions obtained by combining the prior art teachings would have the same unexpected characteristics as the claimed composition.

In view of all of the above this rejection is maintained.


JEFFREY SIEW
SUPERVISORY PATENT EXAMINER